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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,222	11/05/2003	Kate O'Hara	100041-41188	7987
27805	7590	09/06/2005	EXAMINER	
THOMPSON HINE L.L.P. 2000 COURTHOUSE PLAZA , N.E. 10 WEST SECOND STREET DAYTON, OH 45402			HENDERSON, MARK T	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/702,222

Applicant(s)

O'HARA, KATE

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED OFFICE ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 2, 9, 13-18, 20-26 have been amended for further examination. Claims 27-33 have been added.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-13, 16-33 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers (1,527,248) in view of Harris and further in view of Bostroem.

Bowers discloses in Fig. 1, a notebook comprising a stack of bound printed lined sheets (13) coupled to a cover having an outer perimeter and an elongate (depthwise) opening (14) located therein and formed through the thickness thereof (see Fig. 4 and 5); wherein the opening (14) is sized to receive a writing instrument (ink well 15 to represent a writing instrument in its broadest sense) therethrough and generally spaced away from outer perimeter (see Fig. 1); a coupled cover (10) and supplemental cover (11) which is movable to an open and closed position, and having a thickness greater than each sheet (see Fig. 4 and 5) and wherein the cover lacks any opening; wherein the sheets and cover are aligned; wherein the sheets include a plurality of printed lines (see Fig. 1); wherein the opening (14) includes an enlarged portion (see Fig. 5, wherein the diameter of ink well has a larger inside diameter portion).

However, Bowers does not disclose: a retaining mechanism to secure the cover in a closed position; wherein the binding mechanism is a spiral binder; wherein the opening is located adjacent to the binding mechanism; wherein the sheets and the cover include a plurality of binding holes; wherein each opening is at least 6 inches in length with a length-to-width ration of 6:1; wherein the opening is sized to receive a writing instrument of a length of 4 inches to 7 inches and a width of 1/8 - 1 inch; a tear guide line extending parallel to an edge of paper; and wherein the cover covers about 50% of the openings and configured to retain the writing instrument.

Bostroem discloses in Fig. 7 and 8, a notebook comprising a retaining mechanism (A) having a snap portion, wherein the mechanism is attached to a cover and can be coupled to a supplemental cover.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Harris' notebook with a retaining mechanism as taught by Bostroem to keep the covers secured in a closed position.

However, Bowers as modified by Boestrem does not disclose: wherein the binding mechanism is a spiral binder; wherein the opening is located adjacent to the binding mechanism; wherein the sheets and the cover include a plurality of binding holes; wherein each opening is at least 6 inches in length with a length-to-width ration of 6:1; wherein the opening is sized to receive a writing instrument of a length of 4 inches to 7 inches and a width of 1/8 - 1 inch; a tear guide line extending parallel to an edge of paper.

Harris discloses in Fig. 1, 5 and 7, a notebook comprising: a spiral binding mechanism (25) to secure a stack of sheets (24) to a cover (23); wherein the cover and sheets include binding holes (see Fig. 5) located adjacent an inner edge (22); a tear guide line (12 in Fig. 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bower's and Bostroem's notebook with a spiral binding mechanism wherein the sheets have tear guide lines as taught by Harris for providing alternative notebook wherein the sheets and cover are more secured, and wherein the sheets can be removably secured.

In regards to **Claim 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the elongate openings at any location, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the openings at any location, since applicant has not disclosed the criticality of having the openings at a particular position, and invention would function equally as well in any location.

In regards to **Claims 16, 17 and 23**, it would have been an obvious matter of design choice to construct the openings and writing instrument at any desired size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been obvious to construct the openings and writing instrument at any size, since applicant has not disclosed the criticality of having a particular opening and writing instrument size, and invention would function equally as well if constructed in any size.

1. Claims 14 and 15 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers in view of Bostroem and Harris, and further in view of Vernon (672,723).

Bowers as modified by Bostroem and Harris discloses a notebook comprising all the elements as claimed in Claim 1, and as set forth above.

However, Bowers does not disclose wherein the opening includes an enlarged portion centrally located along a length of the opening, wherein the enlarged portion extends in a direction perpendicular to the length of the opening.

Vernon discloses in Fig. 2, a notebook comprising an enlarged portion centrally located along a length of the opening, wherein the enlarged portion extends in a direction perpendicular to the length of the opening.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bowers', Bostroem's, and Harris' notebook with an opening having an enlarged portion as taught by Vernon so that the end user may remove the writing instrument from the opening.

#### ***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Ritter et al discloses a similar notebooks.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

Bowers is now used for disclosing a bound notebook having a cover and sheets, wherein the sheets have an opening within the sheets' closed perimeter.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

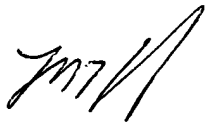
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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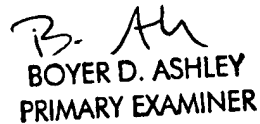
**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Boyer Ashley, can be reached at (571) 272-4502. The formal fax number for TC 3700 is (571) 273-8300.



MTH

August 28, 2005



BOYER D. ASHLEY  
PRIMARY EXAMINER